

REMARKS

Claims 1-38 are pending in the present application.

Claims 1, 33, and 34 have been amended to recite the phrase "a tobacco rod including a tobacco-containing mat having a tubular form." Support is found throughout the specification and in the claims as originally filed. In particular, support can be found in paragraph [0030].

No new matter has been added. Reconsideration and allowance are respectfully requested in view of the following remarks.

Claim Rejections Under 35 U.S.C. § 112, First Paragraph

Claims 1-37 stand rejected under 35 U.S.C. § 112, first paragraph, for lack of written description. With respect to the phrase "a tobacco-containing mat having a tubular form and incorporated into a tobacco rod of the electrically heated cigarette" recited within Claims 1, 33, and 34, as previously presented, the Official Action alleges that "while the instant application provides precedent for a tobacco-containing mat circumscribing said tobacco rod, no such precedent has been found for incorporating the mat into the rod" (see page 2 of the Official Action, second paragraph).

Claims 1, 33, and 34 have been amended to recite the phrase "a tobacco rod including a tobacco-containing mat having a tubular form," which replaces the previously presented phrase "a tobacco-containing mat having a tubular form and incorporated into a tobacco rod." Support is found throughout the specification, including at paragraph [0030]:

[0030] FIGS. 1 and 2 illustrate a preferred embodiment of the electrically heated cigarette 23. However, it should be understood that the

electrically heated cigarette can have other configurations suitable for smoking in an electrically powered lighter. The electrically heated cigarette 23 comprises a tobacco rod 60 and a filter tipping 62 joined together by tipping paper 64. The tobacco rod 60 preferably includes a tobacco web or "mat" 66 folded into a tubular form about a free-flow filter 74 at one end and a tobacco plug 80 at the other end.

Applicants note that the electrically heated cigarette of Claim 1 comprises a tobacco rod 60 that includes a tobacco web or mat 66 folded in a tubular form. Based on these claim amendments, as described above, Applicants submit that Claims 1, 33, and 34 satisfy the written description requirement. Thus, Applicants respectfully request the withdrawal of the rejection of Claims 1, 33, and 34.

Claim Rejections Under 35 U.S.C. § 102

Claims 1, 2, 4, and 5 stand rejected under 35 U.S.C. §102(b) over *McCarty* (U.S. Patent No. 3,744,496).

MPEP §2131 provides that a claim is deemed anticipated "only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference" (emphasis added; MPEP quoting *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 2USPQ2d 1051, 1053 (Fed. Cir. 1987)). Thus, a proper *prima facie case of anticipation* requires that a single reference, provided by an Examiner, discloses each of the claimed elements as interpreted by one of ordinary skill in the art.

Applicants traverse and assert that a *prima facie* case of anticipation has not been established. Applicants assert that *McCarty* does not disclose the electrically heated cigarette of Claim 1 in that *McCarty* does not disclose the combination of features recited in **Claim 1**, as amended, comprising (emphasis added):

a tobacco rod including a tobacco-containing mat having a tubular form;
at least one sorbent; and
a flavoring-release additive including at least one flavoring,
wherein the flavoring is releasable from the flavoring-release additive by heating the electrically heated cigarette to at least a minimum temperature within the electrical smoking system that generates tobacco smoke without combustion of the electrically heated cigarette.

The **Official Action** (at page 4, emphasis added) states:

McCarty teaches a carbon filled inner wrapper for "incorporation into" a tobacco column or for wrapping a tobacco column of a cigarette. Said inner wrapper is typically coated by an outer wrapping of conventional cigarette paper (Column 1, Lines 34-44), and in the inventive process said inner wrapper is constructed from pulped tobacco stalks or stems (Column 2, Lines 20-36). The *McCarty* wrapper which contains activated carbon (Column 2, Lines 51-66) or a "sorbent" is understood to read in claim 1 as a "tobacco-containing mat having a tubular form." *McCarty* further clearly sets forth that "this invention also provides an excellent method for the addition of flavorants to a cigarette ... The carbon holds the flavorant until it is released by the heat of the burning zone to go into the sidestream of mainstream smoke."

The Examiner alleges that *McCarty's* cigarette, which includes "carbon filled inner wrapper" comprising "pulped tobacco stalks or stems" and "flavorants," anticipates the electrically heated cigarette of Claim 1 comprising "a tobacco rod including a tobacco-containing mat having a tubular form; at least one sorbent; and a flavoring-release additive including at least one flavoring" However, *McCarty* only discloses tobacco in the wrapper of a cigar as shown in the following excerpt from *McCarty*:

The fiber pulps or the **tobacco materials** used to make **cigar wrap** are preferred. Thus, in addition to wood and flax fibers, the furnish may be pulped **tobacco materials** used to make **cigar wrap** are preferred. Thus, in addition to wood and flax fibers, the furnish may be pulped **tobacco stalks or stems** to which is added the carbon filler or the carbon may be added to the furnish used in making **reconstituted tobacco sheets** for **cigar wrap**.

Ideally, the **carbon filled paper** is used as an inner wrap under a normal outer wrap for the tobacco column of the cigarette or cigar. Conventional **cigarette paper or cigar wrap** is used as the outer wrapping for the smoking article. Such a combination reduces the tobacco weight

necessary to make a satisfactory product, increases the tobacco rod firmness and does not alter the appearance of the **cigarette or cigar** since the outer wrap hides the grey carbon filled inner liner. (Col. 2, lines 28-36).

Contrary to the Examiner's interpretation of *McCarty*, the above excerpt shows that *McCarty* discloses, as distinct embodiments, the components of: (1) a cigar comprising a cigar wrap composed of **tobacco materials** and wood/flax fibers as an outer wrap, and a carbon filled paper as an inner wrap; and (2) a cigarette comprising a carbon filled paper (inner) overlaid by a cigarette paper (outer). Applicants note that only *McCarty's* cigars are described as containing tobacco materials as a component of a cigar wrap. Since *McCarty* does not disclose the inclusion of "a tobacco material" as a component of either the "carbon filled paper" or the "cigarette paper" of **a cigarette**, *McCarty* cannot anticipate the claimed electrically heated cigarette comprising "a tobacco rod including a tobacco-containing mat having a tubular form; at least one sorbent; and a flavoring-release additive including at least one flavoring" Absent a disclosure of all recited elements of independent Claim 1, a *prima facie* case of anticipation has not been established. Applicants respectfully request the withdrawal of the rejection of Claims 1, 2, 4, and 5.

Claim Rejections Under 35 U.S.C. § 103

MPEP §2143 provides that to establish a *prima facie* case of obviousness, three basic criteria must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) there must be reasonable expectation of success; and (3) the prior art reference

(or references when combined) must teach or suggest all the claim limitations. "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the Applicant's disclosure." (MPEP sec. 2143 quoting *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)).

-I-

Claims 1-15, 17-23, 25-32, and 34-37 stand rejected under 35 U.S.C. §103(a) over *Shi* (U.S. Patent Publication No. 2005/0000531 A1) in view of *McCarty*.

With respect to the rejection of independent Claim 1 dependent Claims (2-15, 17-23, and 25-32), Applicants traverse and assert that a *prima facie* case of obviousness has not been established. Applicants assert that *Shi* and *McCarty*, in combination, do not disclose the combination of features recited in independent Claim 1 directed to an electrically heated cigarette. In the above section, Applicants have explained the deficiencies of *McCarty* in failing to disclose "a tobacco mat" included within a tobacco rod of an electrically heated cigarette. In the present Official Action, the Examiner acknowledges that "As correctly pointed out by Applicant in the Office Action reply Dated October 27, *Shi* fails to disclose 'a tobacco mat' in the electrically heated cigarette." Thus, *Shi* and *McCarty*, in combination, do not disclose all recited elements of Claim 1, which includes "a tobacco rod including a tobacco-containing mat having a tubular form; at least one sorbent; and a flavoring-release additive including at least one flavoring" Absent a disclosure of all recited elements of independent Claim 1, a *prima facie* case of obviousness has

not been established. Applicants respectfully request the withdrawal of the rejection of Claims 1-15, 17-23, and 25-32.

With respect to the rejection of independent Claim 34 and dependent Claim 35, Applicants traverse and assert that a *prima facie* case of obviousness has not been established. For reasons provided above, Applicants assert that *Shi* and *McCarty*, in combination, do not disclose the combination of features recited in independent **Claim 34** directed to an electrically heated cigarette, comprising (emphasis added):

a tobacco rod including a tobacco-containing mat having a tubular form;
at least one sorbent; and
at least one flavoring-release additive in a form selected from the group consisting of beads, a film, and an inclusion complex,
wherein each flavoring-release additive includes at least one flavoring,
wherein the flavoring is releasable from the flavoring-release additive by heating the electrically heated cigarette to at least a minimum temperature within the electrical smoking system that generates tobacco smoke without combustion of the electrically heated cigarette.

Absent a disclosure of all recited elements of independent Claim 34, a *prima facie* case of obviousness has not been established. Applicants respectfully request the withdrawal of the rejection of Claims 34-35.

With respect to the rejection of Claims 36 and 37, Applicants traverse and assert that a *prima facie* case of obviousness has not been established. For reasons provided above, Applicants assert that *Shi* and *McCarty*, in combination, do not disclose the combination of features recited in **Claim 36** directed to a method of making an electrically heated cigarette of Claim 34. Absent a disclosure of all recited elements of independent Claim 34, a *prima facie* case of obviousness has not been established. Applicants respectfully request the withdrawal of the rejection of Claims 36-37.

-II-

Claim 7 stands rejected under 35 U.S.C. §103(a) over *Shi* and *McCarty* as applied to Claim 6 and in view of *Wakamiya* (U.S. Patent No. 6,056,974).

Applicants traverse the rejection of dependent Claim 7 because a *prima facie* case of obviousness has not been established for independent Claim 1 (from which Claim 7 depends) for reasons set forth in the above section. Absent a disclosure of all elements recited in independent Claim 1, Applicants assert that Claim 7 is patentable over *Shi*, *McCarty*, and *Wakamiya*. Thus, Applicants respectfully request the withdrawal of the rejection of Claim 7.

Claim 16 stands rejected under 35 U.S.C. §103(a) over *Shi* as applied to Claim 14 and Applicants' disclosure.

Applicants traverse the rejection of dependent Claim 16 because a *prima facie* case of obviousness has not been established for independent Claim 1 (from which Claim 14 depends) for reasons set forth in the above section. Absent a disclosure of all elements recited in independent Claim 1, Applicants assert that Claim 16 is patentable over *Shi*. Thus, Applicants respectfully request the withdrawal of the rejection of Claim 16.

-III-

Claim 19 stands rejected under 35 U.S.C. §103(a) over *Shi* and *McCarty* as applied to Claim 14 and in view of *Bradley* (U.S. Patent No. 4,195,645).

Applicants traverse the rejection of dependent Claim 19 because a *prima facie* case of obviousness has not been established for independent Claim 1 (from which Claim 19 depends) for reasons set forth in the above section. Absent a

disclosure of all elements recited in independent Claim 1, Applicants assert that Claim 19 is patentable over *Shi*, *McCarty*, and *Bradley*. Thus, Applicants respectfully request the withdrawal of the rejection of Claim 19.

-IV-

Claims 23-25 stand rejected under 35 U.S.C. §103(a) over *Shi* and *McCarty* in view of *Demain* (U.S. Patent No. 5,144,946).

Applicants traverse the rejection of dependent Claims 23-25 because a *prima facie* case of obviousness has not been established for independent Claim 1 (from which Claims 23-25 depend) for reasons set forth in the above section. Absent a disclosure of all elements recited in independent Claim 1, Applicants assert that Claims 23-25 are patentable over *Shi*, *McCarty*, and *Demain*. Thus, Applicants respectfully request the withdrawal of the rejection of Claims 23-25.

Claim 27 stands rejected under 35 U.S.C. §103(a) over *Shi* and *McCarty* as applied to Claim 22 and the Applicants' disclosure.

Applicants traverse the rejection of dependent Claim 27 because a *prima facie* case of obviousness has not been established for independent Claim 1 (from which Claim 22 depends) for reasons set forth in the above section. Absent a disclosure of all elements recited in independent Claim 1, Applicants assert that Claim 27 is patentable over *Shi* and *McCarty*. Thus, Applicants respectfully request the withdrawal of the rejection of Claim 27.

Claim 33 stands rejected under 35 U.S.C. §103(a) over *Shi* as applied to Claim 1, and based on the Examiner's position "that it is old and well known practice to utilize a lighter during the smoking of a cigarette."

Applicants traverse and assert that a *prima facie* case of obviousness has not been established. Applicants assert that *Shi* does not disclose the combination of features recited in independent **Claim 33** directed to an electrical smoking system comprising (emphasis added):

a lighter having electrically heated heating elements; and
at least one electrically heated cigarette including:
 a tobacco rod including a tobacco-containing mat having a tubular
form;
 at least one sorbent; and
 a flavoring-release additive including at least one flavoring,
wherein the flavoring is releasable from the flavoring-release additive by
heating the electrically heated cigarette to at least a minimum temperature within the
electrical smoking system that generates tobacco smoke without combustion of the
electrically heated cigarette.

The **Official Action** sets forth the Examiner's reasoning as (at page 16):

Although *Shi* does not explicitly set forth the components of a smoking system as including both a cigarette and a lighter, it would be obvious to one of ordinary skill in the art engaged in the smoking of a cigarette as taught by *Shi* to pair the disclosed smokable cigarette with a heat source or "lighter" capable of igniting said smokable cigarette. Inclusively, said cigarette and said lighter constitute the claimed smoking system.

Applicants assert that *Shi* does not disclose the combination of features recited in independent Claim 33 directed to a smoking system, comprising "a lighter having electrically heated heating elements; and at least one electrically heated cigarette including: a tobacco rod including a tobacco-containing mat having a tubular form; at least one sorbent; and a flavoring-release additive including at least one flavoring" As noted in the above section, the Examiner acknowledges in the present Official Action that "As correctly pointed out by Applicant in the Office Action

reply Dated October 27, *Shi* fails to disclose 'a tobacco mat' in the electrically heated cigarette" (see page 5 of Official Action, lines 14-16). In the above section in which the rejection of Claim 1 is traversed, Applicants have already explained the deficiencies of *McCarty* in failing to disclose "a tobacco mat" included within a tobacco rod of an electrically heated cigarette. Thus, regardless of whether the recited "lighter having electrically heated heating elements" is well known or not, Applicants assert that *Shi* does not disclose all recited elements of Claim 33 directed to a smoking system, which includes "a lighter having electrically heated heating elements; and at least one electrically heated cigarette including: a tobacco rod including a tobacco-containing mat having a tubular form; at least one sorbent; and a flavoring-release additive including at least one flavoring" Absent a disclosure of all recited elements of independent Claim 33, a *prima facie* case of obviousness has not been established. Applicants respectfully request the withdrawal of the rejection of Claim 33.

Claim 38 stands rejected under 35 U.S.C. §103(a) as applied to Claim 33. The Examiner's position is that "cigarette lighters containing 'a plurality of electrical resistance heating elements sequentially heating the electrically heated cigarette' are old and well known in the art."

Applicants traverse the rejection of dependent Claim 38 because a *prima facie* case of obviousness has not been established for independent Claim 33 (from which Claim 38 depends) for reasons set forth in the above section. Absent a disclosure of all elements recited in independent Claim 33, Applicants assert that a *prima facie* case of obviousness has not been established. Thus, Applicants respectfully request the withdrawal of the rejection of dependent Claim 38.

CONCLUSION

From the foregoing, further and favorable action in the form of a Notice of Allowance is respectfully requested and such action is earnestly solicited.

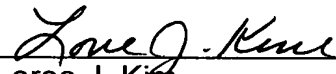
In the event that there are any questions concerning this amendment, or the application in general, the Examiner is respectfully requested to telephone the undersigned so that prosecution of present application may be expedited.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

Date: March 29, 2007

By:


Loree J. Kim
Registration No. 53126

P.O. Box 1404
Alexandria, VA 22313-1404
703 836 6620